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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/654,116 08/30/00 MORGAN

A 180042.418C2

EXAMINER

HM12/0830

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ART UNIT

PAPER NUMBER

1645

DATE MAILED:

08/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. **09/654,116**

Applicant(s) **Morgan et al**

Examiner **Patricia A. Duffy**

Art Unit **1645**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4 and 19, drawn to a growth blocking agent directed to a vitamin B12 binding site of TcII, classified in class 424, subclass 130.1.
 - II. Claims 5-10, and 19 drawn to a growth blocking agent directed to a vitamin B12 binding site on a TcII/B12 complex, classified in class 424, subclass 130.1.
 - III. Claims 11-14 and 19, drawn to a growth blocking agent directed to a clearing site, classified in class 424, subclass 130.1.
 - IV. Claims 15 and 19, drawn to a monoclonal antibody agent consisting of "2-2, 3-11, 4-7, 5-19, and 7-14", classified in class 424, subclass 141.1.
 - V. Claim 16, drawn to a method of inhibiting cell division, classified in class 424, subclass 130.1.
 - VI. Claims 17-18, drawn to a method of inhibiting cellular uptake, classified in class 424, subclass 130.1.
 - VII. Claim 20, drawn to a method of treating a neoplastic disorder, classified in class 424, subclass 130.1.

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2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions I, II, and III are unrelated. The inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation or they have different functions or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are materially and functionally distinct. The growth blocking agents of Groups I, II and III are directed towards different binding sites and thus are material and functionally distinct and will have different modes of blocking growth. In addition, prior art searches require non-patent literature searches. The literature search for the invention of Group I would not be expected to reveal all the relevant references for the invention of Groups II and III, the literature search for the invention of Group II would not be expected to reveal all the relevant references for the invention of Groups I and III, the literature search for the invention of Group III would not be expected to reveal all the relevant references for the invention of groups I and II and therefore the search and examination would be unduly burdensome.

4. Inventions IV and I/ II/III are unrelated. The inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation or they have different functions or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the growth blocking agents of Group IV and I/II/III are materially and functionally

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distinct and will have different modes of blocking growth due to the distinct binding sites. The literature search for the invention of Group IV would not be expected to reveal all the relevant references for the invention of Groups I/II/III, and therefore the search and examination would be unduly burdensome.

5. Inventions V, VI and VII are unrelated. The inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation or they have different functions or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct, each from the other because the methods of Groups V, VI, and VIII represent different inventive endeavors. The methods are unrelated in operation and have different ingredients, method steps, goals and end results. In addition, the methods require different fields of search. The search for Group V would not be expected to reveal all the references relevant to Groups VI/VII, the search for Group VI would not be expected to reveal all the references relevant to Groups V/VII, the search for Group VII would not be expected to reveal all the references relevant to Groups V/VI, and therefore the search and examination would be unduly burdensome.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if

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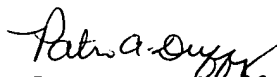
one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy, Ph.D. whose telephone number is (703) 305-7555. The examiner can normally be reached on Tuesday-Saturday from 10:00 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.

Patricia A. Duffy, Ph.D.
August 28, 2001


Patricia A. Duffy, Ph.D.
Primary Examiner
Group 1600